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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,949	09/10/2003	Jahangir Rastegar	10002Z	3511
7590	04/01/2004		EXAMINER	
Thomas Spinelli 2 Sipala Court East Northport, NY 11731			SHAKERI, HADI	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,949

Applicant(s)

RASTEGAR ET AL.

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-20 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 16, line 8, "Fig. 1" should be changed to, -- Fig. 9--; X-reference should be amended to include US Patent No.

Appropriate correction is required.

Claim Objections

2. Claim 12-15 are objected to because of the following informalities: terminology as recited in claim 12, i.e., "anvil" is objected to since, it appears "impact mass (803) is being claimed, which in view of the embodiment claimed in claims 16-20, would create undue ambiguity, since impact mass (1108) in the latter embodiment and as disclosed in the specification performs the similar function and not the anvil (1104). Appropriate correction is required.

3. Regarding claim 15, a plurality of cams, e.g., as in Fig. 13, requires plurality of anvil surfaces (808) and impact masses (anvil) 803. Although Applicant may be as broad as possible, the claim as recited appear to encompass embodiments, e.g., plurality of cams cooperating with at least one impact mass and one anvil surface, which cannot be supported by the specifications as originally filed, however, claims are not rejected under 35 USC 112 paragraph, since it does not appear (at this point) that Applicant is claiming subject matter not disclosed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 12 recites the limitation "the spring" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

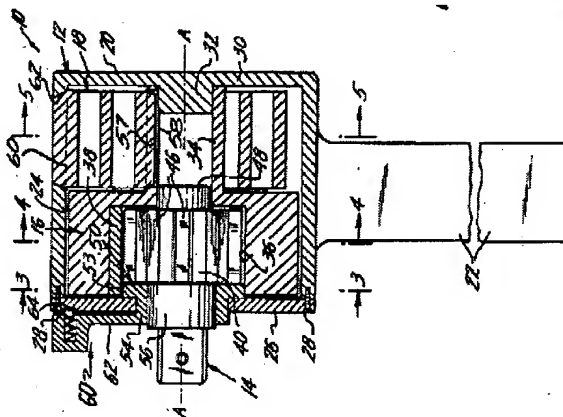
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

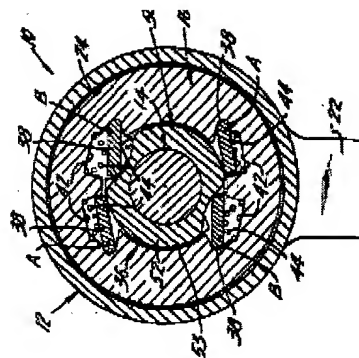
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson, US Patent No. 4,243,109.

Anderson discloses all the limitations of claim 1, i.e., a manually operated impact tool comprising a driven member (14) having means for retaining and driving a fastener and having at least one impact stop (46), a driving member (12) rotatably connected to the driven member, an impact mass (16) movable along a path in communication with the stop (through 38), energy storing means (18) for storing energy upon rotation of the driving member, and energy releasing means (50) for releasing the stored energy.



Regarding claim 2, the means for retaining and driving a nut (limitations given to the workpiece is not accorded patentable weight), i.e., (14), is formed for mating cooperation with a socket which inherently meets the limitation of a hexagonal recess.



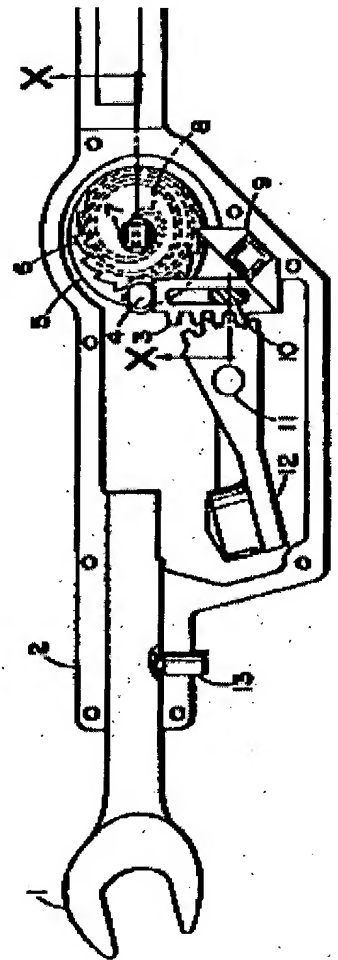
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Regarding claims 3 and 4, Anderson meets the limitations.

Regarding claims 5-11, Anderson meets the limitations, e.g., adjustment means (64) (66).

9. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Russ, US Patent No. 4,474,091.

Russ discloses all the limitations of claim 12, i.e., A manually operated rotatable impact tool comprising: a driven member (2) having means (shown here by 1) for retaining and driving a fastener about an axis, the driven member further having at least one anvil surface (cooperating with 12) offset from the axis; a driving member rotatably connected to the driven member for driving the driven member about the axis to loosen or tighten the fastener, the driving member having at least one anvil (impact mass 12) in cooperation with the at least one anvil surface; biasing means (spring 8) for biasing the at least one anvil surface and at least one anvil together; at least one cam (ratchet 6) for engaging a surface (e.g., 3, 9, gear rack) of the driving member and for moving the at least one anvil apart from the corresponding at least one anvil surface upon rotation of the cam and for releasing the driving member such that the spring pulls the at least one anvil to impact the corresponding at least one anvil surface to create a torque around the axis.



Regarding claims 13 and 14, Russ meets the limitation, i.e., (teeth 6) and rack gear.

Regarding claim 15 in view of objection above, Russ meets the limitations, i.e., wherein the at least one cam comprises two cams (ratchet 6 and disc 5) each rotatably disposed in the driven member and equally distanced from the axis.

Allowable Subject Matter

10. Claims 16-20 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: driven member having at least one anvil, i.e., movable stop, offset from the axis rotatably disposed in the driven member into and out from a path and impact mass movable along the path with a flexible member along with the other limitations as recited in claim 16 has placed these claims allowable over prior art.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-11 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U. S. Patent No. 6,679,143 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is anticipated by the above US Patent, as follows: a driven member; impact stop, a driving member rotatably connected to the driven member, an impact mass movable along a path in communication with the stop, energy storing means for storing energy upon rotation of the driving member, and energy releasing means for releasing the stored energy.

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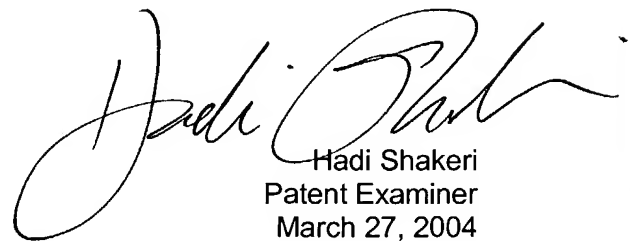
Conclusion

14. It is noted that although informal drawings with the specification of the parent Application now, US Patent No. 6,679,143, included Figs. 15 and 16, the US Patent as published does not include the figures. Applicant may wish to file a certificate of correction to include the figures.

15. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Anderson, Swenson, Gross et al. and Garver are cited to show related inventions.

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279 for unofficial documents. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 6:00 PM. All official documents may be faxed to (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1148.



Hadi Shakeri
Patent Examiner
March 27, 2004